

REMARKS

Claims 1 to 14 are currently pending. Claims 1 and 8 have been amended. Applicants respectfully request reconsideration and withdrawal of the rejections for the following reasons.

35 U.S.C. § 102 (b)

Claim 1 stands rejected as anticipated by U.S. Pat. 5,639,778. However, the compound disclosed at column 5, line 48 falls outside the scope of the presently amended claim. Accordingly, withdrawal of the rejection is requested.

35 U.S.C. §112, second paragraph

Claims 8-9 and 13 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 has been amended in accordance with the examiner's suggestion on page 3 of the Office Action. Regarding claims 9 and 13, the method claimed incorporates both multiple ingredient compositions and separate administration of the compounds of the present invention and other anticancer agents. Applicant does not believe that this interpretation of the claim language renders the claims indefinite.

35 U.S.C. § 112, first paragraph

Claims 9, and 11-14 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Office Action suggests on page 4 that no testing data has been provided. However, it is well-settled law that testing data, or working examples, are not required to fulfill § 112, first paragraph. Despite this fact, the specification does indeed provide data beginning on page 17, line 30, stating that compounds of the present invention inhibit farnesyl transferase with IC 50 values between 1nM and 100µM. From this information, it can be correlated that the compounds of the present invention have potential use for effectively inhibiting or treating cancer. Accordingly, the claims are indeed enabled and withdrawal of the rejection is respectfully requested.


Although claims 9 and 13 stand rejected for failing to include "specific dosage changes," there is no requirement under the patent laws for requiring such detailed disclosure in order to satisfy the enablement requirement. Furthermore, although it is suggested on page 5 that claims 9 and 13

are "reach-through" claims because the claims allegedly encompass anticancer agents that have not yet been discovered, the specification clearly states that the additional anticancer agents include only *known* anticancer agents. *See*, specification, page 17, line 18. Accordingly, Applicant respectfully requests withdrawal of the rejection.

Applicant believes that the claims are now in condition for allowance. An early Office Action to that effect is therefore, earnestly solicited.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Maureen S. Gibbons", written over a horizontal line.

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